

Appln No. 09/973,303

Amdt date July 23, 2004

Reply to Office action of April 26, 2004

REMARKS/ARGUMENTS

Claims 1, 3-9, and 34-40 are currently pending in this application. Claims 1 and 35 have been amended. The amendments find full support in the original specification, claims, and drawings. No new matter has been added. In view of the above amendments and remarks that follow, reexamination, reconsideration, and an early indication of allowance of claims 1, 3-9, and 34-40 are respectfully requested.

Claims 1, 2-9, and 34 are rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner contends that the checkout (POS) terminal which Applicant has provided as support for both the "means for reading" and the "means for electronically recording" recited in claim 1, is duplicative. Applicant submits that this rejection has been obviated because claim 1 no longer includes the limitation of a "means for electronically recording." Applicant therefore respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, 2nd paragraph.

Claims 1, 2-9, and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,923,735 (Swartz) in view of U.S. Patent No. 6,204,763 (Sone). These claims are also alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz in view of U.S. Patent No. 5,482,139 (Rivalto). Applicant respectfully traverses these rejections.

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Independent claim 1, as amended, is directed to a "system for controlling product items with shelf-life limitations" that includes "an electronic receipt electronically storing the read shelf-life limitation information for the selected product item, the electronic receipt being provided to a purchaser of the product item." Independent claim 35, as amended, is directed to a "system for controlling product items with shelf-life limitations" that includes "a first terminal . . . generating an electronic receipt electronically storing the associated shelf-life limitation information for the product item, the electronic receipt being provided to a purchaser of the product item." Applicant submits that none of the cited references teach or suggest the claimed "electronic receipt" or "first terminal" generating the claimed "electronic receipt."

The Examiner contends that Swartz discloses an electronic receipt in that it discloses "a record of customer purchases downloaded from the store server." (See, Office action, Section 9). Although not expressly stated, the Examiner appears to rely on the customer checkout file disclosed in Swartz in making the contention.

First, although the disclosed customer checkout file includes the customer's store transaction file including price and product information of the items that have been scanned by a customer, such a checkout file is created and stored in the store computer, and provided to a store cashier in response to a request for the file to the store computer. (See, Col. 10, lines 53-55). Nothing in Swartz indicates that the customer checkout file is later forwarded to a purchasing customer by the

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store cashier, or that the purchasing customer has any other access to this file. Thus, Swartz' customer checkout file is not an "electronic receipt" that is "provided to a purchaser of the product item" as is recited in claims 1 and 35.

Second, nothing in Swartz teaches or suggests that the disclosed customer checkout file stores "shelf-life limitation information" for a product selected for purchase. The only mention of any shelf-life limitation information in Swartz is found in column 7, lines 37-40. In there, Swartz states that "[t]he store computer 73 contains information about each bar coded product inside the store 76. This information includes price, pricing methods, expiration date, nutrition data, recipes, etc." Aside from being stored in the "store computer," Swartz does not explain in which file of the store computer the information is stored, and much less that the expiration date information is stored in an "electronic receipt" that is "provided to a purchaser of the product item."

Even if assuming, *arguendo*, that Swartz discloses an "electronic receipt electronically storing the . . . shelf-life limitation information" that is "provided to a purchaser of the product item," Swartz fails to teach or suggest a processor that adds the shelf-life limitation information retrieved from the electronic receipt to an inventory list of products purchased by the purchaser, "the processor further detecting an expired product based on the shelf-life limitation information, and removing the expired product from the inventory list." To make up for this deficiency, however, the Examiner relies on the

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disclosure in Sone, and alternatively, on the disclosure in Rivalto.

With respect to Rivalto, the Examiner relies on the disclosure in column 5, lines 18-22 which states that "the control processor 102 is able to use the inventory record memory 112 as a means for automatically tracking and removing dated and/or perishable goods from the inventory by knowing precisely when the particular expiration dates will occur." Rivalto does not disclose, however, how the inventory record memory is populated with expiration dates, and much less, that such information is retrieved from some electronic medium such as an electronic receipt for later adding to an inventory list of products purchased by the purchaser.

Even if Rivalto and Sone were to teach the recited processor, a person of skill in the art would not have been motivated to modify the system of Swartz with the teachings provided by either Rivalto or Sone. This is because Swartz is concerned with a self-checkout system that decreases the amount of checkout time and provides accurate, real-time product information, and is not concerned at all with any type of inventory management based on shelf-life limitation information. It is well established that an Examiner cannot establish a *prima facie* case of obviousness merely by locating references which describe various aspects of a patent applicant's invention -- the Examiner must also "show some objective teaching in the prior art . . . that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references" (In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); see also, Ex

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parte Levengood, 28 USPQ2d 1300, 1302 (BPAI 1993)). The Examiner here fails to point to any objective evidence which would motivate one of ordinary skill in the art to modify Swartz' self-checkout system to include inventory management based on shelf-life limitation information. In fact, no such motivation can exist because inventory management based on shelf-life limitation information does nothing to promote an efficient and accurate self-checkout system that Swartz desires to achieve.

The Examiner appears to rely on the inventory control system disclosed in Rosenweig (U.S. Patent No. 6,188,991) which allows a user to determine which recipes could be made from the user's inventory as a motivation to combine Swartz with either Rivalto or Sone. In doing so, the Examiner contends that the combination would allow one to implement the process taught in Rosenweig, but in a healthier manner since expired products could be removed from the inventory list. However, Applicant respectfully submits that this may not act as a motivation for adding inventory management capabilities to a self-checkout system that merely focuses on efficient and accurate checkout of customers. The Examiner's reasoning may at best support an argument as to why there is motivation to combine Rosenweig with either Sone or Rivalto, but Applicant respectfully submits that it does not support an argument as to why there is motivation to combine Swartz with either Sone or Rivalto. Accordingly, Applicant submits that claims 1 and 35 are now in condition for allowance.

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Claims 3-9, 34, 36-40 are also in condition for allowance because they depend on an allowable base claim, and for the additional limitations that they contain.

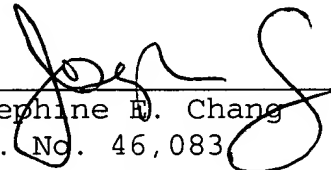
In view of the above amendments and remarks, reconsideration, reexamination, and an early indication of allowance of claims 1, 3-9 and 34-40 are respectfully requested.

Applicant respectfully requests a telephone interview with the Examiner if there are any issues that remain unresolved despite the above amendment and remarks.

Respectfully submitted,

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